

**REMARKS**

Applicant has carefully reviewed and considered the Final Office Action mailed on July 26, 2005, and the references cited therewith.

Claims 1, 3-5, 8-9, 13, and 16-17 are amended, and no claims are canceled or added; as a result, claims 1, 3-5, 8-9, 13, and 16-17 are now pending in this application.

Applicant has amended the above claims in the interest of advancing prosecution of the present case. However, the applicant respectfully notes that the present office action should not be final. That is, the Leiman, et al., reference (U.S. Patent No. 6,469,796) provided by the Examiner as grounds for 103 rejection of claims 9 and 17 does not appear to have been cited in any previous Office Actions.

MPEP 706.07(a), third paragraph, states:

A second or any subsequent action on the merits in any application . . . should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to have been claimed.

Applicant's present claim language, which recites that "the plurality of characteristics including an input/output protocol, a host device type, an application being used to print the document, a job queue status, and a time of day", was present in independent claim 9 in the preceding response that resulted in the Examiner rejecting claim 9 in the January 10, 2005 Office Action. In Applicant's response to the January 10, 2005, Office Action, the cited language was unaltered. In the July 26, 2005, Final Office Action, the Leiman reference was newly introduced as grounds for 103 rejection of claims 9 and 17, to cover the previously present "a job queue status, and a time of day".

As such, Applicant respectfully submits that, in light of MPEP 706.07(a), utilizing the newly cited Leiman reference does not provide proper grounds for a final rejection of the claims. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the final rejection.

**§102 Rejection of the Claims**

Claims 1, 8, and 16 were rejected under 35 USC §102(e) as being anticipated by Shima (U.S. Patent No. 6,149,323). Applicant respectfully traverses the rejection as follows.

Applicant does not admit that the Shima reference is indeed prior art that covers claims as currently presented, however, in the interest of furthering prosecution of the present application, Applicant has amended all claims to assert that the methods being claimed are performed “automatically,” i.e., without requiring user input.

With regard to independent claim 1, on page 2 the Examiner cites the Shima reference as describing, “gathering historical document data . . .”, “correlating each prior print setting selection . . .”, and “comparing . . . the correlated print setting selections . . .”. Regarding independent claim 8, on page 3 the Examiner cites Shima as describing, “gather[ing] prior document data . . .”, “comparing . . . the prior print settings selections . . .”, and “selecting . . . a print setting”. Each of the citations in the Shima reference referred to by the Examiner appears to require the user to actively select, determine, specify, or decide a specific setting value. For example, column 2, lines 50-51, states, “selecting the setting value selected by the user from the existing setting values stored in the storage device”, column 3, lines 17-19, states, “The names of the stored setting values can be displayed in the form of a list (or a table), enabling the user to readily select a desired setting value”, column 3, lines 24-25, states, “it becomes much easier for the user to select a desired setting value”, column 5, lines 2-3, “a new setting value is determined according to the operation of a mouse or a keyboard 53 by the user”, column 5, lines 36-37, states, “the user specifies a specific setting value on the list through use of a cursor”, and column 7, lines 3-5, states, “At the sight of the contents of the displayed setting value “B1,” the user can decide whether the contents of the setting value are acceptable or not.” Thus, Shima appears to describe the user doing the correlating, comparing, and selecting that constitute gerund verbs forms in method claims 1 and 8, with only gathering being done by the print system.

In contrast, independent claim 1, as amended, recites, “automatically gathering”, “automatically correlating”, and “automatically comparing”. Independent claim 8, as amended, recites, “automatically gathering”, “automatically comparing”, and “automatically selecting”. Preceding all gerund verb forms with the adverb “automatically” is supported by page 11, lines 8-14, of the specification of the present application, which recites:

As described above, the various embodiments of the system and method of the present invention provide a distinct advantage by

automatically selecting an optimum print quality setting based on data relating to document content, print setting selections, user input and/or one or more characteristics relating to the print request.  
Advantageously, a user is not required to manually select or change the desired print quality for each print request.

Independent claim 16, as amended, similarly includes the adverb “automatically” as a qualifier prior to each gerund verb form.

As such, Applicant respectfully submits that each and every element and limitation of independent claims 1, 8, and 16 is not present in the Shima reference. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 102 rejection of independent claims 1, 8, and 16, as well as those claims that depend therefrom.

*§103 Rejection of the Claims*

Claims 3-5 were rejected under 35 USC §103(a) as being unpatentable over Shima (U.S. Patent No. 6,149,323) as described in claim 1 above, and in view of Miller, et al. (U.S. Patent No. 5,731,823). Applicant respectfully traverses the rejection as follows.

Regarding independent claim 5, as amended, the Examiner appears to take Official Notice when discussing the Miller reference by stating on page 5, lines 8-10, “[T]he user’s prior print settings (adjusting and/or modifying a stored print setting values files (i.e. print modes) to delete and/or change to a different attributes are widely known in the art . . .” By stating the purpose of the invention as “using computer software with minimal operator input” in column 2, lines 39-43, Miller appears to teach away from user input playing a major role in determining print settings based on comparison of text and image content. Nowhere in Miller deals with saving user preferences as a resource to refer back to for “a user’s prior print setting preference associated with prior documents having a similar amount of text data and image data” playing a role in “automatically selecting a print setting for the document from the plurality of print settings based on the comparison.” Having user input play a major role would be contrary to the purpose of the invention described in the Miller reference.

Taking into account the reasons provided above regarding the 102 rejection based on the Shima reference, Applicant respectfully submits that each and every

element and limitation of independent claim 5 is not described, taught, or suggested in the Shima and Miller references, either individually or in combination, and that claim 5 is in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 103 rejection of independent claim 5, as well as those claims that depend therefrom.

For the reasons provided above regarding the rejection of independent claim 1, Applicant submits that independent claim 1, from which claims 3 and 4, as amended, depend, are in condition for allowance. From Applicant's review of the Miller reference, the reference does not cure the deficiencies of Shima. That is, Miller does not "automatically correlat[e] each prior print setting selection with one or more characteristics of the historical document data, including a user's prior print setting preference". Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 103 rejection of dependent claims 3 and 4.

Claims 9, 13, 17 were rejected under 35 USC §103(a) as being unpatentable over Shima (U.S. Patent No. 6,149,323) as described in claim 1 above, and in view of Leiman, et al. (U.S. Patent No. 6,469,796). Applicant respectfully traverses the rejection as follows.

Regarding claims 9 and 17, the Examiner cites the Leiman reference as describing, "analyzing a plurality of characteristics relating to document data in the document including a job queue status (job status, fig. 11), and a time of day (time submitted, fig. 11)." The reference does not show, either in the figures or the specification, that the "type of print media being printed" is considered when "automatically analyzing a plurality of characteristics relating to document data in a current document".

In contrast, Applicant's claims 9 and 17, as amended, each recite:

automatically analyzing a plurality of characteristics relating to document data in a current document, the plurality of characteristics including an input/output protocol, a host device type, an application being used to print the document, a job queue status, a time of day, and a type of print media being printed;

Support for the added language is found on page 9, lines 7-12, of the present application, which recites, "Examples of print request characteristics unrelated to the content of the document include . . . a job queue status, a time if day of the print request and a type of media being printed."

Taking into account the reasons provided above regarding the 102 rejection based on the Shima reference, Applicant respectfully submits that each and every element and limitation of independent claims 9 and 17 is not described, taught, or suggested in the Shima and Leiman references, either individually or in combination, and that claims 9 and 17 are in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 103 rejection of independent claims 9 and 17, as well as those claims that depend therefrom.

For the reasons provided above regarding the rejection of independent claim 9, Applicant submits that independent claim 9, from which claim 13, as amended, depends, is in condition for allowance. From Applicant's review of the Leiman reference, the reference does not cure the deficiencies of Shima. That is, Leiman does not "automatically analyz[e] a plurality of characteristics relating to document data in the current document, the plurality of characteristics including an input/output protocol, a host device type, an application being used to print the document, a job queue status, a time of day, and a type of print media being printed". Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 103 rejection of dependent claim 13.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney Charles F. Moore at (360) 212-8369.

At any time during the pendency of this application, please charge any additional fees or credit overpayment to the Deposit Account No. 08-2025.

**CERTIFICATE UNDER 37 CFR §1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AF Commissioner for Patents, P.O. BOX 1450 Alexandria, VA 22313-1450, on this 26<sup>th</sup> day of September, 2005.

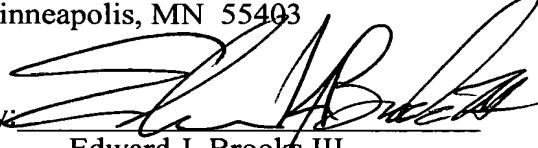
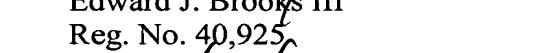
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